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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,573	01/18/2001	David Michael Bains	13DV13120	4682

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EXAMINER

KIM, CHONG HWA

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,573

Applicant(s)

BAINS ET AL.

Examiner

Chong H. Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges the applicant's response/reconsideration to the Office action made on May 8, 2002.

Allowable Subject Matter

1. The indicated allowability of claims 1-20 is withdrawn in view of the newly discovered 35 U.S.C. 112 1st paragraph issues. Rejections based on the newly raised issues follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 and 25-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 and 12 recite the step limitations wherein the filter is weighed to determine the contaminant level in the filter. However, it is not fully described in the specification how such filter is weighed. It appears that the method of weighing the filter is one the most important aspects of the invention. If it is, then it is imperative that the applicants describe how the filter is weighed in the system as shown in Figs. 1-3. If the filter is taken out of the system physically and manually weighed on a scale to determine the level of contaminants, then such practice is

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common knowledge and would be obvious to a person of ordinary skill in the art to perform such steps for the determination. On the other hand, if the filter is somehow weighed automatically in the system, then such method must be described in the specification and shown in the drawings. Nonetheless, neither method is shown in the drawings nor described in the specification.

Furthermore, claims 4, 6, 13, 14, and 25 recite the step limitations wherein the filter 20 as shown in Fig. 1 is soaked in the solvent 32 as shown in Fig. 2 and claims 12 and 29 recite the step limitations wherein the second filter is fluidly connected to the gearbox in the system. The specification also describes that the system shown in Fig. 2 is combined with the system shown in Fig. 1 "to make up the overall system of the present invention" on page 5, lines 5-6. First, it is not clear how the systems shown in Figs. 1 and 2 are combined to operate the lubricant and the solvent separately in one system. Second, it is not clear how the filter 20 is soaked in the solvent 32 as shown in Fig. 2. It appears that the filter 20 is physically taken out of the system as shown in Fig. 1 and soaked in the solvent 32 that is not part of the system as shown in Fig. 1. Third, it is not clear where the second solvent is in the drawings. Fourth, it is not clear as to what is the second filter that allows the oil-based fluid to be flushed through the gearbox as recited in claim 6. In conclusion, the specification and the drawings lack the description on how the system performing a clean check on a gearbox provides such steps or apparatus as discussed above to be carried out by a person of ordinary skill in the art.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Damm et al., U.S. Patent 6,457,564 B1.

Damm et al. shows, in Fig. 1, a system for performing a clean check on a gearbox 3 having an inlet (down arrow) and outlet (up arrow), the system comprising;

- a source of an oil-based fluid (L) fluidly connected to the gearbox inlet;
- a filter 24 fluidly connected to the gearbox outlet; and
- a pump means 18 for causing the oil-based fluid to flow through the gearbox and the filter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Damm et al.

Damm et al. shows, as discussed above in the rejection of claim 21, the system for performing a clean check on a gearbox comprising the filter and the oil-based fluid, but fails to show the filter being a 3 micron collection filter and the oil-based fluid being MIL-L-23699 oil.

It would have been obvious to a person of ordinary skill in the art to make the filter and the oil-based fluid of Damm et al. a 3 micron collection filter and MIL-L-23699 oil, respectively, since such modification would have involved a mere change in the material that is needed for a certain environment. A selection of known material based on its suitability for the intended use is well known in the art and is generally recognized as being within the level of ordinary skill in the art. *In re Leshin*, 125 USPQ 416.

Response to Arguments

8. Applicant's arguments with respect to claims 25-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fluid analyzer for oils.

Coates et al., U.S. Patent 6,452,179 B1

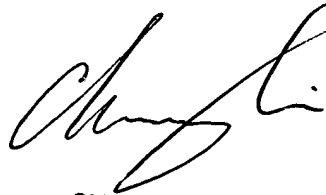
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CHK
November 4, 2002



CHONG H. KIM
PRIMARY EXAMINER